UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/699,876 | 11/04/2003 | Satoshi Nishikawa | 00862.023296. | 3495 |

5514          7590          03/31/2008
FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

| EXAMINER |
|---|
| WILLS, LAWRENCE E |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2625 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 03/31/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 10/699,876 | NISHIKAWA, SATOSHI |
| | Examiner | Art Unit | |
| | LAWRENCE E. WILLS | 2625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on <u>26 December 2007</u>.

2a) ☒ This action is **FINAL.**     2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) <u>1,3,4,11,13,14,21,23 and 24</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1,3,4,11,13,14,21,23 and 24</u> is/are rejected.

7) ☒ Claim(s) <u>11</u> is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All  b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

## DETAILED ACTION

### *Response to Arguments*

1.      Applicant's arguments, see page 9, lines 5-11, filed 12/26/2007, with respect to claim 21 have been fully considered and are persuasive. The rejection under 35 USC 101 of claim 21 has been withdrawn.

2.      Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Objections*

3.      Claim 11 is objected to because of the following informalities: "A data data generating method" (page 4, line 6) should read "A print data generating method". Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

4.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.      Claims 1, 4, 11, 14, 21, and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Livingston (US Patent No. 7,061, 632).

Regarding claims 1, 11, and 21, Livingston'632 teaches an information processing

apparatus having a generation function of generating print data to be transmitted to a printer

(Shown in FIG. 1 is a high level block diagram of a system including a computer 100 and an

imaging device, such as printer 102, in which the program module operates to generate hard

copy, column 3, lines 43-46), comprising: a storage which saves document data to be converted

to print data together with setting data (Random access memory (RAM) 108 serves as temporary

storage for the application program, a printer driver, and the program module, column 3, lines

50-52), an entire print setting unit (All pages selection, column 5, line 18) configured to set an

entire color mode (feature) to the print setting data as a setting of the entire document data

(applies the feature to every page in the document, column 5, lines 18-19), wherein the entire

color mode specifies whether color printing or monochrome printing is to be performed for the

entire document data (To select a single printer for receiving all of the pages of document the

user would select the "All Pages" option from the pull down menu, column 7, lines 33-35); a

partial print setting unit (In addition to the preset page classes, program module 202 includes a

configuration to apply the selected feature or features to an arbitrary page or pages of the

document created by the user. The pages to which the user desires to apply the feature or

features may be specified individually or as part of a range, column 5, lines 30-35) configured to

set a partial color mode to the print setting data independently of the entire color mode as a

setting of a predetermined unit of the document data, wherein the partial color mode specifies

whether color printing or monochrome printing is to be performed for the predetermined unit of

document data; (For this capability, program module 202 would receive information from the

application program specifying which pages include color. With this information from the

application program, program module would cause those pages of the print job including color to

be sent to the selected destination printer. Another preset page class includes monochrome only

pages. This preset page class would allow the user to direct monochrome only pages to a

selected destination printer); and a print data generating unit (printer driver 204 Fig. 2)

configured to issue a color mode specifying instruction in accordance with the entire color mode

and the partial color mode set for the print setting data and generate the print data (Next, in step

606, program module 202 sets the values of the variables in the array of data structures

corresponding to the pages to which the user assigned features. Finally, in step 608, program

module 202, sends the data for the pages to the destination imaging device through printer driver

204. column 9, lines 21-30), wherein said print data generating unit applies the partial color

mode to the predetermined unit of the document data for which the partial color mode is set and

applies the entire color mode to the remaining portion of the document data for which the partial

color mode is not set (In addition, program module 202 passes the values of the variables in the

data structure to printer driver 204 so that the imaging operation can be performed on a per page

basis according to the values of the variables in the corresponding data structure. column 9, lines

21-30).

Regarding claims 4, 14, and 24, Livingston'632 teaches wherein said printing data

generating unit (printer driver 204 Fig. 2) determines whether the printer copes with a change of

the color mode (Step 606, Fig. 6) before the print data containing the instruction of changing the

color mode is generated by using the generating function (Step 608, Fig. 6), when the printer

copes with the change, generates, by using the generating function, printing data containing the

instruction of changing the color mode, and when the printer does not cope with the change,

generates, by using the generating function, print-data containing no instruction of changing the

color mode (In addition, program module 202 passes the values of the variables in the data

structure to printer driver 204 so that the imaging operation can be performed on a per page basis

according to the values of the variables in the corresponding data structure. column 9, lines 21-

30, the values of the variables will decided if data is changed or not).


### *Claim Rejections - 35 USC § 103*

6.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

7.      Claims 3, 13, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Livingston (US Patent No. 7,061, 632) as applied to claim 1 above, and in further view of Petz

(WO 2002/82362 A2—US Patent Application Pub. No. 2004/0187087 is used in lieu of English

translation).


        Regarding claims 3, 13, and 23, Livingston'632 fails to teach wherein the predetermined

unit of the document data is a chapter formed by a plurality of original pages.

        Petz'362 teaches the predetermined unit of the document data is a chapter formed by a

plurality of original pages, (notice Fig. 6A).

Having a system of Livingston'632 reference and then given the well-established

teaching of Petz'362 reference, it would have been obvious to one having ordinary skill in the art

at the time the invention was made to modify the image processing system of Livingston'632

reference to include chapters that are formed by a plurality of original pages as taught by

Petz'362 reference, since the combination would allow for the user to have greater control over

the output of a print job.

### *Conclusion*

8.      The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Kawamoto et al.              US Patent 6,120,197

Mori et al.                  US Publication No. 2004/0111675

Sakura                       US Publication No. 2007/0146767

9.      Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action.  In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to LAWRENCE E. WILLS whose telephone number is (571)270-

3145.  The examiner can normally be reached on Monday-Friday 9:30 AM - 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, King Poon can be reached on 571-272-7440.  The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system.  Status information for published applications

may be obtained from either Private PAIR or Public PAIR.  Status information for unpublished

applications is available through Private PAIR only.  For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


/King Y. Poon/
Supervisory Patent Examiner, Art Unit 2625

LEW
March 24, 2008